

REMARKS

Claims 1-8, 10-25, 30-34, and 41-50 are pending in the application. Claims 1-8, 10-25, and 30-34 have been previously examined on the merits and rejected. In response to that rejection, the Applicant made minor amendments to claims 1-3, 10, 11, 20-25, 31-34, and presented new claims 41-50. Now after having already searched and rejected claims 1-8, 10-25, 30-34, the Examiner believes that those claims represent five independent and distinct inventions and that the new claims represent a sixth independent and distinct invention.

The Applicant has provisionally elected to prosecute claims 41-50 but traverses the restriction requirement for the following reasons.

First, the Examiner's action is in contravention of MPEP Section 811 which requires that the restriction requirement be made "as soon as the need for [it] develops". The minor amendments made to the claims have not altered the scope of the existing claims such that a need for restriction has developed. The inventions identified by the Examiner have been in the case since the case was filed. Thus, by instituting a restriction requirement after an examination of the claims has already taken place, the Examiner is ignoring the mandate of MPEP Section 811.

Second, pursuant to MPEP Section 803, it is respectfully submitted that there is no serious burden placed on the Examiner in examining the inventions identified by the Examiner. Indeed, the Examiner has already conducted a search of all of the claims. Thus, the Examiner has not met the requirements of MPEP Section 803

Third, it is respectfully submitted that the Examiner's position regarding restriction/election of the present claims is incorrect. 35 U.S.C. 121 provides for restriction when two or more "independent **and** distinct" inventions are claimed in the same application. MPEP 802.01. The term "independent" means that there is no disclosed relationship between the subjects, i.e they are unconnected in design, operation or effect. It is readily apparent that in the present application, the catheters, expanding/expandable elements and drug delivery means of the six inventions are all related in the way in which they operate, in their effect and largely in their designs. As broadly claimed in method claim 41, the invention involves deploying an occlusion device in a varicose vein and dispensing a sclerosing agent proximal of the occlusion device. The Examiner has argued that six inventions are "distinct", but not that they are all "independent". The statute requires that the inventions be both independent **and** distinct before restriction is allowed. In re Harnisch, 206 U.S.P.Q. 300 at 306 (C.C.P.A. 1980). If the MPEP states the contrary, the statute is controlling. New South

Industries, Inc. v. Apache Grounding Corporation, 4 U.S.P.Q.2d 1890 (M.D. Tenn. 1987) and In re Weber et al., 198 U.S.P.Q. 328 at 333 n. 2 (C.C.P.A. 1978). The mere fact that an additional search is necessary after an amendment is not grounds for restriction. Moreover, as stated above, five of the six inventions have already been searched. In addition, claims 15-19 were not amended. Further, the changes made to the amended claims were, for the most part, only minor changes, e.g. changing the word balloon to element.

With regard to the first four inventions, the Examiner admits that they are related, i.e. that they are not "independent" as required by the statute. The Examiner only argues that they are distinct, but that is only half of the statutory requirement. With regard to the fifth and sixth inventions, the Examiner argues that they are unrelated, i.e. "independent", relative to each other. It is unclear whether the Examiner believes that they are independent relative to the first four inventions. In any event, it seems apparent that inventions five and six are related. One is directed to a method of delivering an intravascular drug to a blood vessel and the other is directed to a method for treating a varicose vein by delivering an intravascular drug (sclerosing agent) to a blood vessel (varicose vein). In other words, the sixth invention is a subset of the fifth invention.

In light of all of the above, it is submitted that the claims are in order for continued examination on the merits, and the Examiner is respectfully requested to reconsider the restriction requirement. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in cursive script, reading "David P. Gordon".

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